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In re Application of
ESKICIOGLU, Ahmet, Mursit, et al.
U.S. Application No.: 09/581,064
PCT No.: PCT/US98/26069
International Filing Date: 09 December 1998
Priority Date: 10 December 1997
Attorney's Docket No.: RCA 88783
For: CONDITIONAL ACCESS SYSTEM FOR
DIGITAL RECEIVERS

DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This decision is issued in response to the "Petition Under 37 CFR 1.47(a)" filed 20 November 2000. Applicant has paid the required petition fee.

BACKGROUND

On 09 December 1998, applicants filed international application PCT/US98/26069 which claimed a priority date of 10 December 1997 and which designated the United States.

On 17 June 1999, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. As a result, the deadline for submission of the basic national fee was extended to expire thirty months from the priority date, i.e., 10 June 2000.

On 08 June 2000, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 24 July 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and a surcharge for providing the oath or declaration later than thirty months from the priority date were required. The Notification also informed applicant that the failure to submit these materials within one month of the date of the Notification would result in abandonment of the application.

On 10 November 2000, applicant's filed a response to the Notification Of Missing Requirements which included a declaration executed by two of the three inventors, and the petition considered herein. The petition seeks acceptance of the application without the signature of the third inventor pursuant to 37 CFR 1.47(a). The submission also included a petition and fee for a three month extension of time to respond to the Notification Of Missing Requirements.

On 23 January 2001, the DO/EO/US mailed a Notification Of Acceptance (Form PCT/DO/EO/903) indicating that, as of 13 November 2000, applicants had satisfied the requirements of 35 U.S.C. 371(c).

DISCUSSION

A. Notification Of Acceptance Mailed 23 January 2001

35 U.S.C. 371(c)(4) requires an applicant to file in the Patent and Trademark Office:

An oath or declaration of the inventor ... complying with the requirements of section 115 of this title and with the regulations prescribed for oaths or declarations of applicants.

Applicants here did have not submitted a fully executed declaration; and no decision has been issued permitting acceptance of the 10 November 2000 declaration under 37 CFR 1.47(a). Accordingly, applicants have not yet satisfied all the requirements of 35 U.S.C. 371(c). The Notification of Acceptance (Form PCT/DO/EO/903) mailed to applicants on 23 January 2001, which indicated 13 November 2000 as the date of receipt of the 35 U.S.C. 371(c) requirements, is therefore appropriately vacated.

B. Petition Under 37 CFR 1.47(a)

In order for the application to be accepted without the signature of the nonsigning inventor, applicants must submit a grantable petition under 37 CFR 1.47(a). A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the proper petition fee, (2) a statement of the last known address of the inventor; (3) an oath or declaration executed by the other inventors on their own behalf and on behalf of the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort. As set forth below, applicants here have satisfied items (1) and (2), but have failed to satisfy items (3) and (4).

The petition included payment of the \$130 petition fee, and it sets forth the last known address of the nonsigning inventor. Items (1) and (2) are therefore satisfied.

With respect to item (3), applicants section 409.03(a) of the Manual of Patent Examining Procedure ("MPEP") states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicant has submitted a declaration that contains an unexecuted signature block for the nonsigning inventor and is executed by the two other inventors. Accordingly, item (3) has been satisfied.

Regarding item (4), the proof required to show that a nonsigning inventor cannot be reached after diligent effort is set forth in section 409.03(d) of the MPEP, which states:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. ...

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Here, the attempts to locate the nonsigning inventor are set forth in the petition and the accompanying declaration of Davida Fornarotto. These materials reveal that the nonsigning inventor was provided with the application materials and seemed prepared to execute the materials before applicants lost contact with him. After losing contact with the nonsigning inventor, Ms. Fornarotto states that she forwarded further mail to the inventor's last known address (which was undeliverable) and emails to his last known email address (none of which were returned). She also contacted a Mr. William Lagoni, the "liaison between the Intellectual Property Legal Office ... and the main office" who serves as an aid "in locating past and present employees." Mr. Lagoni provided Ms. Fornarotto with contact information for the nonsigning inventor (including a business address and telephone number). No firsthand information is provided with respect to the specific efforts made by Mr. Lagoni to locate the nonsigning inventor. Ms. Fornarotto refers to further attempts to reach the inventor by email, but no mention is made as to whether other attempts were made to locate the inventor (i.e., telephone or mail inquiries to the last known business address and telephone numbers provided by Mr. Lagoni). Under the circumstances present here, evidence is required of some additional diligent effort made by applicants to locate the nonsigning inventor after his apparent change of address. Until such evidence is provided, item (4) is not considered satisfied.

Based on the foregoing, applicants have failed to satisfy all the requirements for a grantable petition under 37 CFR 1.47(a). Accordingly, the petition must be dismissed.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

The Notification Of Acceptance (Form PCT/DO/EO/903) mailed 23 January 2001 is hereby **VACATED**.

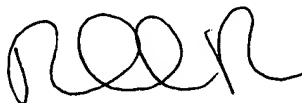
If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Failure to file a timely response will result in abandonment.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the International Division, Legal Staff.



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